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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,257	02/18/2004	Tsuyoshi Nishiwaki	3.0-029C	2220
7590	05/03/2005			
Michael E. Zall Two Yorkshire Drive Suffern, NY 10901			EXAMINER STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 05/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/780,257

Applicant(s)

NISHIWAKI ET AL.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/132,013.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02182004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson 5,782,014. Peterson '014 discloses all the limitations of the claims including the following: (See especially Figure 4, alternate 14 for reference 12) a midsole 4 including a cushioning structure 10, the cushioning structure 10 provided between the outer sole and an upper (see Figure 1); a cushioning structure 10 comprising a thick column-shaped cushioning portion (14, alternate of 12); a plurality of grooves formed on an outer peripheral surface of the cushioning portion (see Figure 4); the respective grooves are helically formed around a substantially vertical axial line (see Figure 4); the respective grooves are arranged substantially parallel with each other (See Figure 4); a range in which each of the grooves is formed is larger than a range of 15 degrees around the axial line and smaller than a range of 180 degrees around the axial line (see Figure 4); a lead angle between the groove and a horizontal plane is set within a range of 35 degrees to 60 degrees (see Figure 4).

3. Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by the ASICS Spring 2002 Footwear catalog (ASICS 2002, whose prices effective July 1, 2002). ASICS 2002 discloses all the limitations of the claims including the following: a midsole including a cushioning structure provided between the outsole and an upper (see page 1, top right figure); the cushioning structure comprises a thick plate-shaped cushioning portion (shown in blue); a plurality of grooves formed on an outer peripheral surface of the cushioning portion (noted as “twist” gel); the grooves are helically formed

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around a substantially vertical axial line (see Figure); the grooves are arranged substantially parallel with each other (in as much as has applicant's Figure 7(b)); a range in which each of the grooves is formed is larger than a range of 15 degrees around the axial line and smaller than a range of 180 degrees around the axial line (see Figure); a lead angle between the groove and a horizontal plane is set within a range of 35 to 60 degrees (see Figure); the grooves are provided to be continuous from an upper end of the cushioning portion to a lower end of the cushioning portion (see Figure); the lead angle is set to be substantially constant from the upper end to the lower end (see Figure); the outer peripheral surface of the cushioning portion is formed to be taper-shaped (see Figure).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Peterson 5,782,014 as applied to claim 1 above. Peterson '014 as applied to claim 1 above discloses all the limitations of the claims except that outer peripheral surface of the cushioning member 14 being taper-shaped. Peterson '014 teaches that the outer peripheral surface of 12 can be taper-shaped (i.e. truncated cone). Since cushion 14 is a replacement of 12, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to taper the outer peripheral surface of 14 as that of 12 to act independently with the modulator portion and provide stable distribution of forces over the regions which include the projections.

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6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over ASICS Spring 2002 Footwear catalog (ASICS 2002, whose prices effective July 1, 2002). ASICS 2002 discloses all the limitations substantially as claimed including the following: a midsole including a cushioning structure provided between the outsole and an upper (see page 1, top right figure); the cushioning structure comprises a thick plate-shaped cushioning portion (shown in blue); a plurality of grooves formed on an outer peripheral surface of the cushioning portion (noted as “twist” gel); the grooves are helically formed around a substantially vertical axial line (see Figure); the thickness of the cushioning part is gradually changed along the grooves and/or the convex portions (see figure). ASICS 2002 does not specifically disclose a cavity in the midsole with the cushioning part in the cavity. ASICS 2002 (first Figure in second row on page 1) teaches that the gels located in the shoe can be pads that are located in cavities and placed within the shoe to aid in cushioning impact of the user’s foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushioning pad and place it in a cavity in the midsole, as taught by ASICS 2002, to aid in cushioning the user’s foot within the shoe.

#### *Response to Arguments*

7. Applicant’s arguments filed December 17, 2004 have been fully considered but they are not persuasive. Applicant argues that the 35 U.S.C. 102(a) rejection presented in the parent application is improper and cannot be used against the applicant because the assignee for the parent and the instant application is the same and 35 U.S.C.102(a) requires that the reference be “invented by another”. This argument is not clearly understood. Firstly, as noted in the rejection above, 35 U.S.C. 102(a) does not require that the reference used against applicant be **invented by another**, only that it be “known or used by another in this country” prior to the invention by the applicant. In this instance, the ASICS Catalog, with a publication date of May 16, 2001, makes the invention know to others in this country

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more than eleven months prior to the date of invention by applicant. The only date the Office can go by, as the date of invention is the date of filing of the parent application, which was April 25, 2002. Since this invention was known or used by others in this country prior to the date of invention by the applicants, the 35 U.S.C. 102(a) rejection is proper. With respect to applicants arguments that ASICS TIGER Corporation is a wholly owned subsidiary of ASICS Corporation and therefore the same assignee in the parent application and the instant application, this argument is not clearly understood. The use of common assignee only applies to 35 U.S.C. 103(c) rejections whereas the references used may only be used under 35 U.S.C. 102(e), (f) or (g) and therefore would not apply to 35 U.S.C. 102(a). The only way applicant can get around the Catalog used as a reference against them is to file a 37 CFR 1.131 affidavit swearing behind the reference.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is fluid and cursive, with the first name "Anthony" written in a larger, more prominent script than the last name "Stashick".

Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS